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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/696,555	10/30/2003	Ian Burgess	2073.0120000/DSC/RLP	5931
26111	7590	06/27/2006	EXAMINER	
STERNE, KESSLER, GOLDSTEIN & FOX PLLC 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			STASHICK, ANTHONY D	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/696,555

Applicant(s)

BURGESS, IAN

Examiner

Anthony Stashick

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 13, 2006 has been entered.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-2, 7, 12-15, 18-19 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Brue' 6,076,282. Brue' '282 discloses all the limitations of the claims including the following: a midsole S having at least one protrusion 1 disposed in a forefoot region; a plate P having at least one receptacle 2 disposed therein; the plate placed adjacent to the midsole such that the receptacle aligns with the protrusion (see Figure 6); the diameter of the receptacle is not greater than the diameter of the protrusion (see Figure 6); an outsole fixedly attached to the plate and the midsole (see col. 6, lines 22-56); the outsole is disposed along the entire length of the shoe (col. 6, lines 22-56); at least one projection is disposed in a forefoot of the outsole (see Figures 2-4 and 6); the plate is fixedly attached to the midsole (by 1a); a cutout 2 in the midsole wherein the protrusion is disposed in the cutout (see Figure 6); the protrusion is disposed in the cutout such that an outward-most extremity of the protrusion approximately aligns with an outward-most surface of the midsole (see Figure 6). With respect to the limitations of

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claims 18 and 19, the mere usage of Brue' '282 in the fashion disclosed would meet the limitations in the claims.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 8-10 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brue' 6,076,282 as applied to claims 1 and 18 above in view of Ludemann 6,199,304. Brue' '282 as applied to claims 1 and 18 above discloses all the limitations of the claims except for a sockliner having at least one nub disposed in a forefoot region on a lower surface and wherein the sockliner is placed on top of the midsole with the nub facing the midsole and an abrasion-resistant material attached to the upper surface of the sockliner with absorbent properties. Ludemann '304 teaches that a sockliner 10 with an upper layer of abrasion resistant and absorbent material (see col. 3, line 27-col. 4, line 28) can be placed on top of a midsole to aid in cushioning the user's foot and providing comfort to the user. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a sockliner, such as that taught by Ludemann '304, on the midsole of Brue' '282 as applied to claims 1 and 18 above, to provide cushioning and comfort to the user's foot.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being obvious over Brue' 6,076,282 as applied to claim 1 above. Brue' '282 as applied to claim 1 above discloses all the limitations of the claims except for a stiff board disposed in the arch area of the shoe. In making shoes, it has been well known to place lasting boards, a stiff board, in the arch area to give support to the user's foot during use. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a

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last board in the arch of the shoe of the references as applied to claim 1 above, to aid in supporting the user's arch during use.

***Allowable Subject Matter***

7. Claims 16-17 are allowed over the prior art of record.
8. Claims 3-6 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments filed April 13, 2006 have been fully considered but they are not fully persuasive. With respect to the Lin reference, applicant's arguments were persuasive and that rejection has been withdrawn. With respect to Brue', applicant argues that the diameter of protuberance 1a is less than that of the receptacle as noted in col. 4, lines 33-35 of Brue'. The examiner would like to direct the applicant's attention to protuberance 1, the wider bottom portion and note that the claims only require "wherein a diameter of said receptacle is not greater than a diameter of said protrusion." (emphasis added). Since the diameter of 1, a protrusion and a diameter of a protrusion, is not greater than a diameter of the receptacle, this limitation of the claims is met by Brue' as currently applied. It appears that applicant is arguing more than that which is claimed, i.e. that the protrusion has only one diameter and that diameter of the protrusion is not less than the diameter of the receptacle. If this is what applicant intends to claim, then similar language should be placed in the claims to limit it as such. With respect to applicant's arguments about the deflecting of the protrusion into the receptacle, it appears applicant is arguing more than that which is claimed. Applicant states, "Thus, the deflection is a bowing of the protrusion as distinguished from extending entirely through the receptacle" in his arguments. The claims

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only require deflection and do not themselves distinguish the type of deflection, therefore, Brue' meets the limitations as claimed.

### ***Conclusion***


10. Applicant is duly reminded that a complete response must satisfy the requirements of 37 C.F. R. 1.111, including: "The reply must present arguments pointing out the specific distinctions believed to render the claims, including any newly presented claims, patentable over any applied references. A general allegation that the claims "define a patentable invention" without specifically pointing out how the language of the claims patentably distinguishes them from the references does not comply with the requirements of this section. Moreover, "The prompt development of a clear Issue requires that the replies of the applicant meet the objections to and rejections of the claims." Applicant should also specifically point out the support for any amendments made to the disclosure. See MPEP 2163.06 II(A), MPEP 2163.06 and MPEP 714.02. The "disclosure" includes the claims, the specification and the drawings.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561. The examiner can normally be reached on Monday through Thursday from 8:30 am until 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Anthony Stashick  
Primary Examiner  
Art Unit 3728

ADS